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| In re Application of | : |
| Jeffrey M. Besterman et al | : |
| Serial No.: 10/628,649 | : PETITION DECISION |
| Filed: July 28, 2003 | : |
| Attorney Docket No.: MET-011DIV | : |

This is in response to the petition under 37 CFR 1.144, filed May 15, 2006, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on July 28, 2003, and contained claims 1-50. In a first Office action, mailed August 31, 2005, the examiner set forth a restriction requirement, as follows:

Group I – Claims 1-4, 8-10, 12-15, 19-21 and 23-24, drawn to the compounds of formula I where Y or Z do not represent a heterocyclic or heteroaryl radical and X is a benzothiophene;

Group II – Claims 1-4, 8-10, 12-15, 19-21 and 23-24, drawn to the compounds not encompassed in Group I;

Group III – Claims 5-7, 11, 16-18 and 22-24, drawn to compounds of formula II where X does not represent a fused heterocyclic ring;

Group IV – Claims 5-7, 11, 16-18 and 22-24, drawn to compounds of formula II not encompassed by Group III;

Group V – Claims 25-28 and 32-37, drawn to methods of use of formula I (inhibiting lactamase activity);

Group VI – Claims 29-31 and 36-37, drawn to methods of use of formula II (inhibiting lactamase activity);

Group VII – Claims 38-41, 45-47 and 49-50, drawn to methods of use of formula I (inhibiting bacterial growth); and

Group VIII – claims 42-44 and 48-50, drawn to methods of use of formula II (inhibiting bacterial growth).

An election of species was also required for whichever group was elected. Each Group was also indicated as subject to further restriction if elected.

The examiner reasoned that the compounds in the Markush group lacked a substantial structural element in common and lacked a common utility and could be divided based upon *In re Harnish* and *Ex parte Hozumi*. The examiner also set forth appropriate reasoning for separating methods from compounds and advised of possible rejoinder.

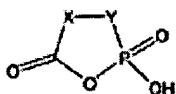
Applicants replied on November 1, 2005, canceling claims 1-4, 8-15, 19-21 and 25-50, and electing the compounds of Group III with traverse and a species, as required. Applicants argued that there would be no undue burden to search all of the claims in the case and requested rejoinder of Groups IV, VI and VIII with elected Group III.

The examiner mailed a new Office action to applicants on January 17, 2006, acknowledging the election of Group III and the species, but maintaining the requirement, and making it Final. The examiner argued against rejoinder of the compound claims based on the value of X, as elected, being a triazole or indazole moiety as opposed to an azepine, thiophene or furanyl moiety in that they formed significantly different core structures and have different functions. The requirement was then made Final. The examiner then rejected claims 6-7 and 23-24 under 35 U.S.C. 112, second paragraph, as indefinite; and under 35 U.S.C. 112, first paragraph, as lacking enablement. Claims 16-18 and 22-24 were also rejected for obvious double patenting over US 6,608,046. All claims were objected to as containing non-elected subject matter.

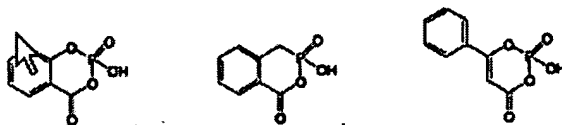
This petition was filed on May 15, 2006, traversing the requirement as improper. A reply to the Office action was also filed in which claims 51-61 were added and the rejections argued or otherwise addressed.

DISCUSSION

A review of the claims of Group III, as filed, shows that they are directed to compounds based on the following structure:



As can be seen formula II appears to be a five member ring with variables X and Y. Y is defined as O or alkylene and X is defined as alkylene, cycloalkylene, fused heterocycle, heteroalkylene or arylene, any of which may be substituted. In essence, X expands the five member ring to six members to which may be fused another ring, as shown by the structures of claim 22:



Applicants traverse the restriction requirement, in part, based on actions of an examiner in a related case with similar claims, stating that a larger group of claims was examined without the question of undue burden being raised. In view thereof, applicants request that Groups II-IV, VI and VIII be examined together. It is noted, however, that all of the claims in Groups II, VI and VIII have been canceled. Applicants also admit that claims of Groups II and IV in the related application overlap with the claims in Group III of this application. Applicants request that claims 29-31, 36-37, 42-44 and 48-50 (Groups VI and VIII) be examined in this application. Since these claims have been canceled, such request is improper absent their reinstatement. Further, these claims are method claims which the examiner had indicated would be subject to rejoinder upon indication of allowability of the compound claims. As the compound claims have not yet been indicated allowable, rejoinder for examination purposes is not required at this time.

Applicants make little argument for rejoining Groups III and IV, both directed to compound claims, but of differing scope. Applicants do state that the same 50 claims were presented in a companion application, but were divided into only four groups by a different examiner without an election of species being required. Restriction of claims in an application to a single invention is a tool an examiner may use in order to effectively examine an application. While consistency in making such requirements is desirable, the fact that one examiner makes a requirement that varies from that of a second examiner on the same or similar claims depends on the perception, understanding, experience and other factors peculiar to each examiner. Obviously, restriction was appropriate in each of the two applications filed by applicants, evidencing general consistency in examination. That the details differ is of minor significance, especially in view of potential rejoinder of compound and method claims. What is of greater significance is applicants attempt to prosecute the same claims in two different applications. Further, election of species is another tool an examiner can employ to have applicants assist in directing the examiner to focus on the most important species claimed within a Markush group.

On the other hand, the examiner's statements at the end of almost every Group setting forth that the Group may be subject to further restriction is inappropriate. Each Group set forth should encompass all that is appropriate for that Group. Further to set forth two different Groups based on the same claims without specifying what the difference between the Groups is – e.g. different structures – is also inappropriate. Here the examiner has based Groups III and IV on the same claims, defined what compounds belong to Group III by defining what X is not and then included anything else in Group IV. No difference in classification is set forth which would suggest that there is no undue search burden on the examiner. Although the examiner propounds that the compounds in the Markush group do not share a common utility and common structure, there is no example or evidence presented that such is the case other than the paragraph on page 7 of the first Office action which is generic to all Groups set forth. However, because there are clear differences in the structure of formula II based on Y alone (i.e. Y is either C or O) and such structures would be classified and searched differently, as well as the broad definition of X, the

restriction requirement between Groups III and IV is deemed appropriate. It is noted that in the species elected Y is O, not C.

DECISION

The petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of applicants' reply filed May 15, 2006, and further action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George C. Elliott.
Director, Technology Center 1600